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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,928	10/21/2003	Masafumi Yamanoue	0033-0906P	3179

2292 7590 04/10/2007
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EXAMINER

AIRAPETIAN, MILA

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/10/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/10/2007.

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mailroom@bskb.com

Office Action Summary	Application No. 10/688,928	Applicant(s) YAMANOUE ET AL.	
	Examiner Mila Airapetian	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 12/19/2006 is acknowledged and entered. Claim 10 has been amended. Claims 1-8 and 10 are currently pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Berstis et al. (hereinafter Berstis) (US 6,282,653).

Claim 1.

Berstis teaches royalty collection system for use of copyrighted digital materials on the internet comprising:

a manipulation unit for selection of a desired electronic copyrighted work (col. 11, lines 37-62);

a copyright royalty information storage unit storing copyright royalty information of an electronic copyrighted work (col. 8, lines 8-10, lines 21-26);

a copyrighted work data storage unit storing electronic copyrighted work data (col. 6, lines 36-42),

a copyright royalty calculation unit calculating a copyright royalty of an electronic copyrighted work selected through said manipulation unit based on the copyright royalty information stored in said copyright royalty information storage unit (col. 5, lines 51-63, lines 36-49);

a communication unit transmitting to an external source the copyright royalty calculated by said copyright royalty calculation unit (col. 8, lines 8-17); and

a copyrighted work data write unit writing into a recording medium electronic copyrighted work data corresponding to the electronic copyrighted work selected through said manipulation unit out from electronic copyrighted work data stored in said copyrighted work data storage unit (col. 5, lines 19-21, lines 25-26).

Claim 2. Berstis fudher teaches said system, further comprising a sales information recording unit recording sales status of a relevant electronic copyrighted work sales apparatus (col. 9, lines 50-53).

Claim 8. Berstis teaches royalty collection system for use of copyrighted digital materials on the Internet, comprising:

a communication unit (col. 7, lines 3-12);

a copyright information storage unit storing copyright information of an electronic copyrighted work to be sold (col. 6, lines 36-42); and

a copyright royalty data storage unit storing for each of a number of copyright holders copyright royalty data received by said communication unit (col. 8, lines 8-10, lines 21-26); and

a copyright royalty data approval processing unit causing said communication unit to transmit to an external source copyright royalty data recorded in said copyright royalty data recording unit when copyright royalty data stored in said copyright royalty data storage unit is approved ("*control routine remainder of the account is then distributed to the content provider;*" col. 8, lines 21-28).

Claim 10. Berstis further teaches a system comprising:

an electronic copyrighted work sales apparatus selling an electronic copyrighted work (col. 2, lines 37-46, lines 63-67);

a copyright management apparatus (central authority) administering a copyright royalty of an electronic copyrighted work sold by said electronic copyrighted work sales apparatus (col. 10, lines 2-7);

a seller terminal used by a seller (col. 7, lines 1-3); and

a copyright holder terminal used by a copyright holder (col. 8, lines 14-25; indicates a holder terminal for transmitting copyrighted files to the seller (source) terminal), wherein said electronic copyrighted work sales apparatus includes a manipulation unit for selection of a desired electronic copyrighted work (col. 11, lines 37-62);

a copyright royalty information storage unit storing copyright royalty information of an electronic copyrighted work (col. 8, lines 15-28),

a copyrighted work data storage unit storing electronic copyrighted work data (col. 7, line 3);

a copyright royalty calculation unit calculating a copyright royalty of an electronic copyrighted work selected through said manipulation unit according to the copyright royalty information stored in said copyright royalty information storage unit (col. 5, lines 36-49, 51-63),

a first communication unit transmitting to said copyright management apparatus (central authority) the copyright royalty calculated by said copyright royalty calculation unit (col. 10, lines 2-7; means for notifying the central authority), and

a copyrighted work data write unit writing into a recording medium electronic copyrighted work data corresponding to the electronic copyrighted work selected through said manipulation unit out from electronic copyrighted work data stored in said copyrighted work data storage unit (col. 5, lines 19-21; lines 25-26);

wherein said copyright management apparatus includes a second communication unit receiving from said copyrighted work sales apparatus copyright royalty data of an electronic copyrighted work sold (col. 10, lines 2-7; notifying the central authority indicates providing communication means for the central authority);

a copyright information storage unit storing copyright information of an electronic copyrighted work to be sold (col. 6, lines 36-42);

a copyright royalty data storage unit storing for each copyright holder copyright royalty data received by said second communication unit according to the copyright information stored in said copyright information storage unit (col. 8, lines 8-10, lines 21-

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26); and

a copyright royalty data approval processing unit causing said second communication unit to transmit copyright royalty data recorded in said copyright royalty data storage unit to said seller terminal when the copyright royalty data stored in said copyright royalty data storage unit is approved from said copyright terminal (col. 9, lines 21-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis in view of Official notice.

Claim 7. Berstis further teaches said system further comprising a recording media storage unit (col. 5, lines 19-21, lines 25-26).

Berstis teaches that said digital files can be stored on a hard drive. Berstis does not specifically teach that said hard drive comprises a plurality of recording media. Official Notice is taken that it is old and well known that hard drives are partitioned into a plurality of independent segments for storing different files. Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made

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to modify Berstis to include that hard drives comprises a plurality of segments because dividing the hard drive into multiple partitions would improve performance and simplify backups (See, for example, US 6,202,070 to Nguyen et al.; col. 1, lines 42-44; col. 24, lines 13-43).

Claims 3-6 are rejected under 35 U.S.C. 102(e) as being unpatentable over Berstis in view of Powell et al. (US 6,317,650).

Claim 3. Berstis further teaches all the limitations of claim 3 except:

said apparatus further comprising an identification information storage unit storing identification information of an electronic copyrighted work sales apparatus; and a sales information control unit sensing attachment of a sales information *readout card* corresponding to the identification information stored in said identification information storage unit, and reading out sales status recorded in said sales information recording unit.

Powell et al. (hereinafter Powell) teaches an e-commerce system employing portable cards wherein vending machine includes CPU and memory storing machine ID.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis to include that said apparatus comprising an identification information storage unit storing identification information of the machine, as disclosed in Powell, because it would advantageously provide a statistical data such as product dispensed counts, paper currency receipt data, coin currency receipt data,

and coin currency return data for a specific machine, as disclosed in Powell (col. 14, lines 62-65).

Berstis also does not teach a sales information control unit sensing attachment of a sales information *readout card* corresponding to the identification information stored in said identification information storage unit, and reading out sales status recorded in said sales information recording unit.

Powell teaches said system including a sales information control unit sensing attachment of a sales information *readout card* corresponding to the identification information stored in said identification information storage unit, and reading out sales status recorded in said sales information recording unit (col. 14, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis to include a sales information control unit sensing attachment of a sales information *readout card* corresponding to the identification information stored in said identification information storage unit, and reading out sales status recorded in said sales information recording unit, as disclosed in Powell, because it would advantageously provide a statistical data such as product dispensed counts, paper currency receipt data, coin currency receipt data, and coin currency return data for a specific machine, as disclosed in Powell (col. 14, lines 62-65).

Claim 4. Berstis teaches all the limitations of claim 4 except that said sales information control unit reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit.

Powell teaches said system including a control unit that reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit (col. 14, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis to include a control unit that reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit, as disclosed in Powell, because it would advantageously provide a statistical data such as product dispensed counts, paper currency receipt data, coin currency receipt data, and coin currency return data for a specific machine, as disclosed in Powell (col. 14, lines 62-65).

Claim 5. Berstis teaches all the limitations of claim 5 except an identification information storage unit storing identification information of an electronic copyrighted work sales apparatus; and

a sales information control unit sensing attachment of a sales information *management card* corresponding to the identification information stored in said identification information storage unit, and reading out and then deleting the sales status recorded in said sales information recording unit.

Powell et al. (hereinafter Powell) teaches an e-commerce system employing portable cards wherein vending machine includes CPU and memory storing machine ID.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis to include that said apparatus comprising an identification information storage unit storing identification information of the machine, as disclosed in Powell, because it would advantageously provide a statistical data such as product dispensed counts, paper currency receipt data, coin currency receipt data, and coin currency return data for a specific machine, as disclosed in Powell (col. 14, lines 62-65).

Berstis also does not teach a sales information control unit sensing attachment of a sales information *management card* corresponding to the identification information stored in said identification information storage unit, and reading out and then deleting the sales status recorded in said sales information recording unit.

Powell teaches said system wherein the system reads the data from the card, and erases the data from the card (col. 4, lines 35-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis to include a sales information control unit sensing attachment of a sales information *management card* corresponding to the identification information stored in said identification information storage unit, and reading out and then deleting the sales status recorded in said sales information recording unit, as disclosed in Powell, because it would advantageously allow to deallocate the memory space used to store record on the card, as specifically taught by Powell (col. 16, lines 12-14).

Claim 6. Berstis teaches all the limitations of claim 6 except that said sales

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information control unit reads out the sales status recorded in said sales information recording unit and then deletes the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit (col. 9, lines 24-45).

Powell teaches said system wherein the system reads the data from the card, and erases the data from the card (col. 4, lines 35-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Berstis to include a sales information control unit sensing attachment of a sales information *management card* corresponding to the identification information stored in said identification information storage unit, and reading out and then deleting the sales status recorded in said sales information recording unit, as disclosed in Powell, because it would advantageously allow to deallocate the memory space used to store record on the card, as specifically taught by Powell (col. 16, lines 12-14).

Response to Arguments

Applicant's arguments filed 12/19/2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that the prior art does not show the use of copyright royalty information stored in a copyright royalty information storage unit for

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copyright royalty calculations, it is noted that Berstis teaches: "*A given content provider thus may subscribe to the service to receive royalty payments for the use of his or her copyrighted content by users of the client machines*" (col. 8, lines 15-18), wherein a "payment" indicates the use of copyright royalty information for calculating copyright royalties.

In response to Applicant's argument that the prior art fails to teach "*any unit for performing royalty rate calculations based on copyright royalty information stored in a copyright royalty information storage unit*", it is noted that the fact of receiving royalty payments by the content provider indicates that said payments were calculated. As per "unit" per se, Berstis teaches a computer-implemented method for royalty calculation, thereby indicating the use of computer/unit implementing said functionality.

In response to Applicant's argument that the prior art does not teach "*a sales information recording unit recording sales status of a relevant electronic copyrighted work sales apparatus*", it is noted that Berstis teaches that one or more digital files are transferred between the certified devices so that a controlled number of file transfers and precise number of file transfers may be readily documented (col. 7, lines 17-21), thereby indicating recording sales status of a relevant electronic copyrighted work sales apparatus.

In response to Applicant's argument that the prior art does not teach "*a copyright royalty data approval processing unit causing said communication unit to transmit to an external source copyright royalty data recorded in said copyright royalty data recording unit after an approval of said copyright royalty data stored in said copyright royalty data*"

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storage unit is received", it is noted that Berstis does, in fact, teach said feature.

Specifically, Berstis teaches "*step 68 may simply test whether the count has a value indicating that further copies may be made... if, however, the outcome of the test at step 68 is positive, the digital file may be transferred to the target*", which indicates the approval unit approving the transfer of digital files.

Applicant argues that the prior art does not disclose a "*structure corresponding to a copyright holder terminal*". Berstis teaches distribution of copyrighted content from content providers to the end users in Internet environment, thereby indicating the use of computers/terminals.

In response to Applicant's argument that a proper motivation for modifying Berstis in view of Official Notice has not been provided, it is noted that the motivation to modify Berstis would be to improve performance and simplify backups.

In response to Applicant's argument that the prior art does not teach that "*said sales information control unit reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit and a remaining portion of said program recorded in said sales information readout card*", it is noted that said sales information control unit reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit (Powell, col. 14, lines 58-65), thereby indicating

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recording and executing all data including "*a remaining portion of said program recorded in said sales information readout card*".

In response to Applicant's argument that the prior art does not teach "*a sales information control unit sensing attachment of a sales information management card corresponding to identification information stored in said identification information storage unit, and reading out and then deleting the sales status recorded in said sales information recording unit*", it is noted that Powell teaches said feature. Specifically, Powell teaches that the system reads the data from the card, and erases the data from the card (col. 4, lines 35-40). The motivation to combine the references would be to deallocate the memory space used to store record on the card, as specifically taught by Powell (col. 16, lines 12-14).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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